**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Thomas C. Anthony

Examiner: Thinh T. Nguyen

Serial No.: 10/679,564

Group Art Unit: 2818

Filed: October 6, 2003

Docket No.: 10014232-1

Title: MAGNETIC MEMORY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

Sir/Madam:

I, Thomas C. Anthony, declare as follows:

1. I am the named inventor of the subject matter described and claimed in the above-identified U.S. Patent Application Serial No. 10/679,564 filed October 6, 2003.

2. The Office Action mailed on September 16, 2004 has been read and understood along with the references cited therein, and that I make this Declaration in support of the patentability of the claims of U.S. Patent Application Serial No. 10/679,564.

3. I, Thomas C. Anthony, am an employee of Hewlett-Packard Company.

4. This Declaration under 37 C.F.R. § 1.131 is made in response to the rejection of claims 1-4 and 6-22 under 35 U.S.C. § 102(e) based on U.S. Patent No. 6,716,644, issued to Nejad et al., entitled "METHOD FOR FORMING MRAM BIT HAVING A BOTTOM SENSE LAYER UTILIZING ELECTROLESS PLATING", having a filing date of May 17, 2002. The Nejad et al. Patent is assigned to Micron Technology, Inc., Boise, ID. For purposes of the September 16, 2004 Office Action, the earliest date that U.S. Patent No. 6,716,644 is available for use as prior art is its filing date of May 17, 2002.

5. Prior to the May 17, 2002 filing date of U.S. Patent No. 6,716,644, issued to Nejad et al., and cited by the Examiner as referenced above, I conceived the above-identified and claimed invention. The claimed invention was constructively reduced to practice via the filing of U.S. Patent Application Serial No. 10/679,564. As factual evidence of my

Declaration under 37 C.F.R. § 1.131
Applicant: Thomas C. Anthony
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conception prior to May 17, 2002, attached hereto and incorporated by reference, is Exhibit A.

6. Exhibit A is a confidential internal Invention Disclosure Record of Hewlett-Packard Company. This Invention Disclosure Record is entitled "MRAM Array With Reference Layer Self-Aligned to Conductor in Damascene Process" and has an internal Hewlett-Packard invention disclosure number of PDNO. 10014232 and was produced prior to the earliest prior art date of May 17, 2002 of U.S. Patent No. 6,716,644, issued to Nejad et al. This document describes the subject matter of the present patent application and supports that the claimed invention of the present patent application was conceived prior to May 17, 2002.

7. After conceiving the claimed invention of the present application, I diligently filed U.S. Patent Application Serial No. 10/679,564 as described in Paragraphs 8-17 below.

8. Invention Disclosure Record 10014232 was forwarded to the law firm of Dicke, Billig, & Czaja, PLLC on July 5, 2001 requesting a quote for preparation and filing of a U.S. Patent Application based upon Invention Disclosure Record 10014232. Dicke, Billig, & Czaja, PLLC received the Invention Disclosure Record 10014232 on July 9, 2001. Dicke, Billig, & Czaja, PLLC is located at Fifth Street Towers, 100 South Fifth Street, Suite 2250, Minneapolis, MN 55402 and specializes in patent, trademark, and copyright law. As factual evidence of forwarding Invention Disclosure Record 10014232 to Dicke, Billig, & Czaja, PLLC in July of 2001, attached hereto and incorporated by reference herein, is Exhibit B.

9. Exhibit B is a letter from Hewlett-Packard Company to Steven E. Dicke of Dicke, Billig, & Czaja requesting a quote of the cost to prepare and file a U.S. Patent Application for a number of Invention Disclosure Records listed on the front of the letter. Included in these Invention Disclosure Records is Invention Disclosure Record 10014232-1, which was forwarded to Dicke, Billig, & Czaja, PLLC along with the letter.

10. Thereafter, Steven E. Dicke, registration number 38,431, of Dicke, Billig, & Czaja, with the assistance of Kevin R. Swanson, registration number 37,948, of Dicke, Billig, & Czaja, began preparation of a U.S. Patent Application based upon Invention Disclosure

Declaration under 37 C.F.R. § 1.131

Applicant: Thomas C. Anthony

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Record 10014232. Such application is the present invention of U.S. Patent Application Serial 10/679,564. As factual evidence of commencement of preparation of U.S. Patent Application Serial No. 10/679,564, attached hereto and incorporated by reference herein, are Exhibits C and D.

11. Exhibit C is a facsimile transmission of Dicke, Billig, & Czaja to me, Thomas C. Anthony of Hewlett-Packard Company. Exhibit C includes a "Fax Transmittal Cover Sheet" dated October 30, 2002, which indicates that 9 pages were sent including the cover page and two Information Disclosures. The two Information Disclosures were Invention Disclosure Records 10014155-1 and 10014232-1.

12. Exhibit D includes three facsimile transmissions to Kevin Anderson of Anderson Illustrating located at 19917 English Court, Farmington, MN 55024. Anderson Illustrating specializes in patent illustrations and was employed to prepare necessary figures for U.S. Patent Application Serial No. 10/679,564. Exhibit D includes a "Fax Transmittal Cover Sheet" dated June 9, 2003, indicating that 9 pages including the cover page and drawings for case H303.147.101 were transmitted to Anderson Illustrating. Case H303.147.101 is Dicke, Billig, & Czaja's reference number for U.S. Patent Application Serial No. 10/679,564 that is based upon the Invention Disclosure Record 10014232. Also, Exhibit D includes a "Fax Transmittal Cover Sheet" dated June 11, 2003, indicating that 6 pages including the cover page and drawings with changes were transmitted to Anderson Illustrating for Dicke, Billig, & Czaja's reference number H303.147.101. In addition, Exhibit D includes a "Fax Transmittal Cover Sheet", dated June 20, 2003 indicating two pages including the cover sheet and a change for Figure 8 were transmitted to Anderson Illustrating for Dicke, Billig, & Czaja's reference number H303.147.101.

13. A draft of the present application, based on Invention Disclosure Record 10014232, was prepared and forwarded to me, Thomas C. Anthony, via an e-mail transmission on June 11, 2003. As factual evidence of the e-mail transmission, attached hereto and incorporated by reference herein, is Exhibit E, which is a "hard copy" of a portion of the e-mail transmission to me, Thomas C. Anthony, dated June 11, 2003.

Declaration under 37 C.F.R. § 1.131

Applicant: Thomas C. Anthony

Serial No.: 10/679,564

Filed: October 6, 2003

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14. A Final Draft of the present invention was prepared by Steven E. Dicke and forwarded via an e-mail transmission on June 23, 2003, to Philip Lyren, an attorney working for Hewlett-Packard Company. As factual evidence of the e-mail transmission, attached hereto and incorporated by reference herein, is Exhibit F, which is a "hard copy" of a portion of the e-mail transmission to Philip S. Lyren dated June 23, 2003.

15. Revisions to the Final Draft application were forwarded in a seven page facsimile transmission from Be Henry for Howard Boyle of Hewlett-Packard Company to Dicke, Billig, & Czaja on August 7, 2003. Instructions were given to Dicke, Billig, & Czaja to amend the document as requested and file the application. As factual evidence of the facsimile transmission, attached hereto and incorporated by reference, is Exhibit G, which is a copy of the cover letter of the facsimile transmission from Be Henry for Howard Boyle to Dicke, Billig, & Czaja.

16. Revisions were made and a final draft of the patent application along with signature papers including a Declaration and Power of Attorney for Patent Application and an Assignment of Patent Application were forwarded via an e-mail transmission on August 22, 2003 to me, Thomas C. Anthony. As factual evidence of the e-mail transmission, attached hereto and incorporated by reference herein, is Exhibit H, which is a "hard copy" of a portion of the e-mail transmission to me, Thomas C. Anthony, dated August 22, 2003.

17. On October 6, 2003, the present application, U.S. Patent Application Serial No. 10/679,564, was timely filed with the U.S. Patent and Trademark Office (U.S.P.T.O.).

18. It is therefore respectfully submitted that the present application claims an invention which was conceived prior to May 17, 2002 and diligently filed with the U.S.P.T.O. Thus, the Nejad et al. reference should be removed as a reference under 35 U.S.C. § 102(e).

Declaration under 37 C.F.R. § 1.131

Applicant: Thomas C. Anthony

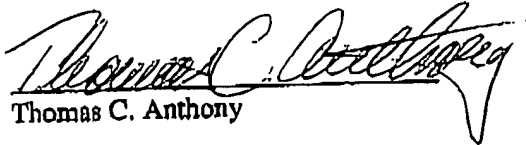
Serial No.: 10/679,564

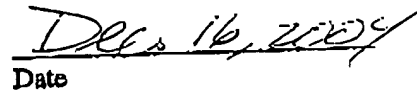
Filed: October 6, 2003

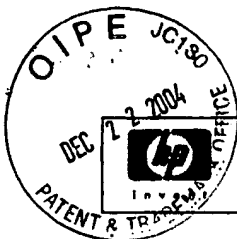
Docket No.: 10014232-1 (H303,147.101)

Title: MAGNETIC MEMORY

19. I further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or patent issued thereon.


Thomas C. Anthony


Date



Write in Dark Ink on F

EXHIBIT A

HP Invention

PDNO 10014232

DATE RCVD

3/22/01

ATTORNEY

Descriptive Title of Invention: *MRAM Array with Reference layer Self-Aligned to Conductor in Damascene Process*

Signature of Inventor(s): Pursuant to my (our) employment agreement, I (we) submit this disclosure on this date: [*3/22/01*].

Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name
<i>267887</i>	<i>Tom Anthony</i>	<i>Thomas Anthony</i>			

Employee No.	Name	Signature	Telnet	Mailstop	Entity & Lab Name

Signature of Witness(es) The invention was first explained to, and understood by, me (us) on this date: []		
Full Name	Signature	Date of Signature
<i>ROBERT SEZER</i>	<i>Robert Sezer</i>	<i>22-MAR-2001</i>

Description of Invention:

A. Description of the construction and operation of the invention (

An MRAM cell is constructed using the Damascene process to create both the bottom conductor and reference layer. First a trench is created in a dielectric layer, the trench is filled with conductor metal (Cu) and then lapped flat. The Cu is then recessed a prescribed amount. After that a reference layer is deposited into the recess and then lapped flat. At this point a barrier, sense layer and top conductor are processed on top of the pinned layer.

B. Advantages of the invention over what has been done before.

The self aligned pinned layer eliminates a masking step in defining the pinned layer and has the pinned layer patterned at minimum pitch (no loss in density associated with alignment process)

Write in Dark Ink on Front Side Only, Please

C. Problems solved by the invention.

- Simplifies MRAM fab process
- Increase density of MRAM arrays

D. Prior solutions and their disadvantages (if available, attach copies of product literature, technical articles, patents, etc.).

- Separate masks used for both pinned and sense layers

Pictures/Flowcharts (if any):

EXHIBIT B



Steven R. Ormiston
PATENT ATTORNEY/OUTSOURCING
MGR

208 396 2544 Tel
208 396 3958 Fax



Hewlett-Packard Company
11307 Chinden Boulevard
Mail Stop 314
Boise, ID 83714
www.hp.com

July 5, 2001

Steven E. Dicke
Dicke Billig & Czaja PA
Suite 1250 701 Building
701 Fourth Ave South
Minneapolis MN 55415



RE: Preparation **and filing** of Patent Applications for the attached Invention Disclosure(s)

[REDACTED]
[REDACTED], 10014232-1, [REDACTED]
[REDACTED]
[REDACTED]

Pursuant to Outside Counsel Procedures Dated October 15, 1999

FILE DIRECTLY TO THE USPTO by: December 12, 2001

Dear Steve:

We would like you to provide us with a quote of the cost for your firm to prepare **and file** (direct with the USPTO) a US patent application based on the HP invention disclosure(s) identified above, a copy of which is enclosed. Your quote should be based on preparing and filing this application **exactly as specified on the attached green checklist**.

You must use HP's USPTO forms and only reference HP's "complete" docket number on all filing documents and correspondences with the USPTO. All filing fees should be charged to HP's deposit account noted on the HP forms. Please do not prepare or file an assignment, HP will do that. Any questions regarding HP's forms and the JetForm software for use with HP's forms should be directed to Jennifer Torres at (858) 655-8008.

Your quote should be submitted on the enclosed Request for Quote And Engagement Letter Agreement. If your quote is accepted, we will return a fully executed copy of the Agreement to you for your records. **The Agreement will not be binding on you or on HP until signed by HP's authorized representative. If the Agreement is not signed and returned to HP, any bills submitted by you cannot be paid.**

Thank you for your assistance in this matter. If your review indicates a possible conflict for your firm, you should advise us within one week of receipt of this letter.

Sincerely,

Chris Griffin for Steven R. Ormiston

Steven R. Ormiston

Enc.: HP Invention Disclosure(s)
RFQ(s) and Outside Counsel Checklist(s)

EXHIBIT C**DICKE, BILLIG & CZAJA, P.A.****Patent • Trademark • Copyright • Attorneys****Suite 1250 • 701 Building • 701 Fourth Avenue South • Minneapolis, Minnesota 55415****Telephone (612) 573-2000****Facsimile (612) 573-2005****FAX TRANSMITTAL COVER SHEET**

Date: October 30, 2002	No. of pages 9 (including this page)
To: Tom Anthony Company: Hewlett-Packard Fax No.: (650) 857-5559 Telephone No.:	From: Kevin Swanson Our Ref.: 303.132.101/H303.147.101 HP Ref.: 10014155-1/10014232-1 Direct Line: (612) 573-2009

Dear Tom,

Per your request, here are copies of the two Information Disclosures I promised you. Please do not hesitate to call me if you have any questions. I can be reached at the number listed above.

**Thank you,
Kevin Swanson**

Please notify us at 612-573-2000 if all pages are not received.

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS ATTORNEY-PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS LISTED ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright • Attorneys

FAX TRANSMITTAL COVER SHEET

Date: June 9, 2003

No. of pages: 9 (including this page)

To: Kevin Anderson

From: Kevin Swanson

Company: Anderson Illustrating

Re: Drawings

Fax No.: 651-460-4380

Our Ref.: H303.147.101

Phone No.: 651-460-4393

Direct Line: 612-573-2009

E-mail: kswanson@dbclaw.com

Kevin,

Here are drawings for a new case, H303.147.101. Please return all figures as soon as you can.

Thanks

Kevin

Please notify us at 612-573-2000 if all pages are not received.

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS ATTORNEY-PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS LISTED ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright • Attorneys

FAX TRANSMITTAL COVER SHEET

Date: June 11, 2003

No. of pages: 6 (including this page)

To: Kevin Anderson

Company: Anderson Illustrating

Fax No.: 651-460-4380

Phone No.: 651-460-4393

From: Kevin Swanson

Re: Drawings

Our Ref.: H303.147.101

Direct Line: 612-573-2009

E-mail: kswanson@dbclaw.com

Kevin,

Here are some changes to the drawings for case, H303.147.101. Please return all figures as soon as you can.

Thanks

Kevin

Please notify us at 612-573-2000 if all pages are not received.

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS ATTORNEY-PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS LISTED ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

DICKE, BILLIG & CZAJA, P.A.

Patent • Trademark • Copyright • Attorneys

FAX TRANSMITTAL COVER SHEET

Date: June 20, 2003

No. of pages: 2 (including this page)

To: Kevin Anderson

Company: Anderson Illustrating

Fax No.: 651-460-4380

Phone No.: 651-460-4393

From: Kevin Swanson

Re: Drawings

Our Ref.: H303.147.101

Direct Line: 612-573-2009

E-mail: kswanson@dbclaw.com

Kevin,

Here is one change to Figure 8 for case, H303.147.101. Please return all figures as soon as you can.

Thanks

Kevin

Please notify us at 612-573-2000 if all pages are not received.

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Kathryn Elseth - 10014232-1/H303.147.101

From: Kathryn Elseth
To: tom.anthony@hp.com
Date: 6/11/2003 3:15 PM
Subject: 10014232-1/H303.147.101
CC: Kathryn Elseth; Kevin Swanson; Steve Dicke

EXHIBIT E

Dear Tom,

Please find attached a first draft of the above-mentioned application and drawings. [REDACTED]
[REDACTED]
[REDACTED]

Thank you,

Kathryn Elseth
IP Legal Assistant
DICKE, BILLIG & CZAJA PLLC
Fifth Street Towers, Ste 2250
100 South Fifth Street
Minneapolis, MN 55402
Direct Dial: (612) 573-0667
Fax number (612) 573-2005
Email: kelseth@dbclaw.com

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EXHIBIT F

Kathryn Elseth - HP Ref. No. 10014232-1; DBC

From: Jolene Neby
To: philip-s.lyren@hp.com
Date: 6/23/2003 2:45 PM
Subject: HP Ref. No. 10014232-1; DBC No. H303.147.101 Final Draft
CC: Dicke, Steve; Elseth, Kathryn

Phil,

Please find attached a FINAL DRAFT for the above-referenced patent application. Please review and return any comments to Steven E. Dicke at sdicke@dbclaw.com or you can reach him by phone at (612) 573-2002. Thanks.

Jolene A. Neby
IP Legal Assistant
Dicke, Billig & Czaja, PLLC
Fifth Street Towers
100 South Fifth Street
Suite 2250
Minneapolis, MN 55402
www.dbc-iplaw.com

Phone: (612) 573-0439
Fax: (612) 573-2005
jneby@dbclaw.com

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EXHIBIT G

Be Henry-Admin to Howard Boyle
Legal Department - MS#110701
20555 SH 249, Houston, TX 77070
Tel: 281-518-5992 (Direct)
Fax: 281-514-8332
Fax: 281-514-7137 (Direct)

Hewlett-Packard Co.

Fax

Dicke, Billig & Czaja PA

To: Patrick Billig **From:** Be Henry / Howard Boyle
Fax: 612-573-2005 **Pages:** 7
Phone: 612-573-2000 **Date:** 8/7/2003
Re: HP PDNO: 10014232-1 (H303.147.101) **Title:** Magnetic Memory

☐ Urgent ☒ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

• **Comments:**

Transmitted herewith are marked up revisions to the specification. [REDACTED]

For further questions, please contact Howard Boyle at 281-518-9645 or email at howard.boyle@hp.com.

Thank you.

Be Henry

Confidentiality Note: The documents accompanying this facsimile transmission contain information from Hewlett-Packard Company which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

If you do not receive all the pages, or if there is any difficulty in receiving, please call: 281-518-5992 and ask for the operator named above.

EXHIBIT H

Kathryn Elseth - 10014232-1/H303.147.101

From: Kathryn Elseth
To: tom.anthony@hp.com
Date: 8/22/2003 2:30 PM
Subject: 10014232-1/H303.147.101
CC: Kathryn Elseth; Kevin Swanson; Steve Dicke

Dear Tom,

Please find attached a FINAL DRAFT of the above-identified patent application. In addition, please find attached a DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION document and an ASSIGNMENT OF PATENT APPLICATION document. Both documents need to be executed by you for filing with the U.S. Patent and Trademark Office. The Assignment document assigns all rights in the patent application from the inventors to Hewlett-Packard Development Company LP.

It is important that you sign and date the Declaration and Power of Attorney document on or before the date that you sign and date the Assignment document.

Due to the timeliness of this matter, please return the signed and dated Declaration and Power of Attorney document and the signed and dated Assignment document to my attention via Federal Express as soon as possible.

If you have any questions, please feel free to contact me at the number listed below.

Thank you,
Kathryn Elseth
IP Legal Assistant
DICKE, BILLIG & CZAJA PLLC
Fifth Street Towers, Ste 2250
100 South Fifth Street
Minneapolis, MN 55402
Direct Dial: (612) 573-0667
Fax number (612) 573-2005
Email: kelseth@dbclaw.com

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